

YAMADA et al.
Appl. No. 10/660,756
Response to Office Action dated March 17, 2008

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 2, 4-6, 8, 9, 11-13 and 18-23 were provisionally rejected under the non-statutory doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of application no. 11/652,472. This rejection is provisional because the referenced claims of application no. 11/652,472 are not yet patented. Applicants do not agree with this rejection. Nonetheless, if the '472 application claims are patented prior to the granting of this application and if otherwise appropriate, Applicants will take steps to address this rejection.

The office action objects to claim 61 and suggests that the word "recording" in line 4 be replaced with the word "received." Claim 61 finds support in the example Figure 5 embodiment described in the subject patent application and has been amended to recite a transmitter for transmitting a command signal, to an external recording server, to record broadcast signals currently being recorded by a recording device installed in the mobile terminal device on the external recording server when the detector detects that the broadcast signal cannot be recorded in the recording device installed in the terminal device. Applicant respectfully requests that the objection to claim 61 be withdrawn.

Claims 18 and 19 were rejected under 35 U.S.C. Section 102(e) as allegedly being anticipated by Lee et al. (U.S. Patent Publication No. 2002/013143).

As previously discussed, Lee et al. describes a system in which a user connects to a data supplying server 300 using a personal computer 100 in order to select a file for downloading to a mobile phone 600 by specifying its telephone number. Data supplying server 300 then attempts to connect to the mobile phone 600 over the mobile communication network 400. Paragraph [0038] of Lee et al. describes that if the connection is not made within some predetermined period of time, the data supplying server 300 can connect to a data storing space 500 for downloading the data.

YAMADA et al.
Appl. No. 10/660,756
Response to Office Action dated March 17, 2008

Claim 18 recites certain operations between a recording server and a mobile terminal device "when a failure of receiving is detected during receiving of the broadcast information by the mobile terminal device." As noted above, paragraph [0038] of Lee et al. recites certain operations when a connection to the mobile phone 600 is not made at all. Consequently, Lee et al. does not describe what happens when the mobile phone 600 experiences a failure of receiving during the receiving. Lee et al. therefore cannot anticipate claim 18 or its dependent claim 19.

In response, page 2 of the office action contends that the mobile phone of Lee et al. could start out in a good area with a connection and then move to a bad area, in which case there would be a failure of receiving. According to the Examiner, when the mobile phone moved to the bad area, data would be transferred to the data storage space 500.

However, contrary to the assertions in the office action, Lee et al. provides no description of such a "scenario" set forth in the office action. Consequently, this scenario amounts to nothing more than a supposition as to how Lee et al. might work if the mobile phone moves to a bad area. There is no showing in the office action that the system of Lee et al. operates in this manner and certainly no showing that Lee et al. anticipates the system of claim 18.

Moreover, while not acquiescing in this rejection or in the characterizations of Lee et al. set forth in the office action, claim 18 has been amended to recite that the mobile terminal sends a command which requires recording to the recording server when a failure of receiving is detected. There is no disclosure in Lee et al. that the mobile phone described therein sends a command which requires recording to data storing space 500 when a failure of receiving is detected. For this additional and independent reason, Lee et al. cannot anticipate claim 18 or its dependent claim 19.

Claims 1-4, 10, 22 and 23 were rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by a proposed combination of Engstrom (U.S. Patent No. 7,065,333) and Lord (U.S. Patent No. 7,054,660). While not acquiescing in this rejection or in the characterizations of Engstrom and Lord in the office action, claims 1 and 10

YAMADA et al.

Appl. No. 10/660,756

Response to Office Action dated March 17, 2008

have been amended. A conforming amendment has been made to claim 4. The discussion below makes reference to the amended claims.

Engstrom discloses a mobile device that includes multiple tuners so that, for example, when a tuner is tuned to a broadcast that is currently playing, another tuner is used to scan for another broadcast based on user preference. When the other broadcast based on user preference is located, the user can selectively play the currently playing broadcast or the other broadcast. See Engstrom, col. 1, lines 57-62. When the mobile device is selected for another purpose, the currently playing broadcast is interrupted and recorded from a point where the interruption occurred. When the other purpose is finished, the recording of the currently playing broadcast is played from the point of interruption. "Other purposes" include making or receiving a telephone call. See Engstrom, col. 1, line 63 to col. 2, line 4; col. 10, line 12 to col. 11, line 3; Figures 7 and 8.

As previously discussed, Engstrom does not teach inquiring whether a broadcast signal should be recorded or not when an incoming or outgoing call is detected as recited in claim 1. Reference is made to col. 11, lines 33-36 of Lord as allegedly providing this feature. However, this portion of Lord simply describes software that is operative to record a broadcast if that broadcast contains requested data. There is no concept here of inquiring whether to record when a call (incoming or outgoing) is detected. Claim 1 provides an option to record when a call is detected. In contrast, Lord describes that recording takes place when a broadcast contains requested data. Consequently, even were Engstrom and Lord combined, the subject matter of claim 1 and its dependent claims 4, 22 and 23 would not result.

Page 2 of the office action contends that Lord "teaches a user requesting the broadcast signal to be recorded, which renders a plurality of scenarios such as an inquiry which prompts the user to request such a recording." Page 9 of the office action references col. 11, lines 33-36 of Lord in connection with such "scenarios." Col. 11 lines 39-40 of Lord mentions that data for immediate use can also be stored by the device if

YAMADA et al.
Appl. No. 10/660,756
Response to Office Action dated March 17, 2008

desired by the user. However, none of these scenarios involves inquiring whether to record the broadcast and Applicant respectfully submits that, absent improper hindsight, this feature of claim 1 cannot be gleaned from Lord.

Claim 10 describes an interface configured to inquire whether a currently received broadcast signal should be recorded or not. As noted above, Lord does not remedy the admitted deficiencies of Engstrom in this regard and consequently claim 10 is not made obvious by the proposed combination of these references.

Claim 5 was rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by the proposed Engstrom-Lord combination, in further view of Lee et al.

Applicant respectfully submits that the proposed combination of Engstrom, Lord and Lee fails to disclose or suggest recording a broadcast signal in a recording device installed in an external recording server as set forth in claim 5. Engstrom and Lord are admitted in the office action to be deficient in this regard. Lee provides no description that would have suggested using an external recording server when the mobile phone is actually connected to the network. In Lee, the external recording server is used when a connection cannot be made. Consequently, claim 5 patentably distinguishes over this proposed combination of references.

Claim 6 was rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by a proposed combination of Engstrom and Cahill (U.S. Patent No. 5,150,384). While not acquiescing in this rejection or in the characterization of the references in the office action, claim 6 has been amended to recite "selectively recording the broadcast signal in the mobile terminal device or in a recording device installed in an external recording server when an incoming or outgoing call is detected." Neither Engstrom nor Cahill discloses or suggests a selective recording feature as claimed and consequently the proposed combination of these references would not make obvious the subject matter of claim 6.

YAMADA et al.
Appl. No. 10/660,756
Response to Office Action dated March 17, 2008

Claims 8, 9, 12-14, 47, 57, 58 and 61 were rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by a proposed combination of Engstrom and Lee.

As previously discussed, the deficiencies of Engstrom and Lee et al. with respect to rejected independent claims 8, 12, 57 and 61 are most easily seen by noting that these claims involve the terminal device (receiving-side) detecting that a broadcast signal cannot be received or recorded.

Lee et al. is cited as remedying the deficiencies of Engstrom. However, in Lee et al., the data supplying server 300 (transmitter-side) detects when a mobile phone cannot be contacted. The cited references, taken either alone or in combination, do not disclose or suggest a terminal device that generates a recording signal for an external device in response to a detection that a broadcast signal cannot be received. Specifically, Engstrom does not disclose an external recording device and, to the extent the data storing device 500 of Lee et al. is argued to constitute a recording device, the server, not the mobile phone, initiates any "recording process" in this recording device.

The dependent claims 9, 13, 14 and 58 recite additional features not shown in the applied references.

The office action responds to the arguments presented in the prior response by contending that Lee et al. teaches the transmitting of a command for recording a currently received broadcast signal in an external recording server when the detector detects that the broadcast signal cannot be received. However, to the extent Lee et al. can be characterized as disclosing the teaching of a command signal for an external recording server, that command signal is clearly not sent from the mobile terminal or communication device that receives a broadcast signal.

With respect to claim 47, paragraph [0038] of Lee et al. describes that if the connection is not made within some predetermined period of time, the data supplying server 300 can connect to a data storing space 500 for downloading the data. There is no concept disclosed in Lee et al. of premising the recording of a broadcast signal in a

YAMADA et al.
Appl. No. 10/660,756
Response to Office Action dated March 17, 2008

recording device installed in an external recording server based on an inability to record the broadcast signal in a recording device installed in a mobile terminal device.

Claim 11 was rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by a proposed combination of Engstrom, Lord and Lee et al.

Claim 11 call for the mobile terminal device to include a transmitter for transmitting a record command when a broadcast cannot be received. Engstrom and Lord are acknowledged to be deficient in this regard. Moreover, as noted above, to the extent Lee et al. is characterized as disclosing the teaching of a command signal for an external recording server, that command signal is not sent from the mobile terminal. Consequently, the proposed combination of Engstrom, Lord and Lee et al. would not have made obvious the subject matter of claim 11.

Claims 20 and 21 were rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by a proposed combination of Lee et al. and Engstrom.

Engstrom does not remedy the deficiencies of Lee et al. with respect to claim 18, from which claims 20 and 21 depend. Consequently, these claims are believed to patentably distinguish over the proposed Lee et al.-Engstrom combination.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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